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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/718,114      | 11/20/2003  | Joe Don Sartor       | 2932                | 9890             |

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UNITED STATES SURGICAL,  
A DIVISION OF TYCO HEALTHCARE GROUP LP  
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EXAMINER

GILMAN, ALEXANDER

ART UNIT PAPER NUMBER

2833

DATE MAILED: 01/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/718,114             | SARTOR ET AL.       |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Alexander D. Gilman    | 2833                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 and 25-39 is/are rejected.
- 7) ☒ Claim(s) 24 and 40 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>03/24/04;09/17/04</u> <u>10/24/05</u>                                     | 6) <input checked="" type="checkbox"/> Other: <u>IDS of 10/24/2005</u>      |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 27-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 27, lines 6-9 recite "...the plug receptacle portion being shaped to receive the plug portion of the electrosurgical instrument of the (?) particular manufacturer and the plug portion of the electrosurgical instrument of any other manufacturer."

It is unclear how plug receptacle being able receive the plug portion of the electrosurgical instrument of any other manufacturer. The specification does not discuss possible configurations of the respective plugs and receptacles and their geometrical limits. It is practically impossible to predict compatibility of the invention receptacle with any of plugs, since the information regarding geometry and configuration limitations for the mating components of different manufacturers is not presented.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8, 27-29, 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Brassel et al.

With regard to claims 1, 7, 8, Brassel et al (US 2004/0030330) disclose a connector system comprising: a plug portion (48) said plug portion (Fig. 10) including a plurality of pins (one of 105, 107) which extend outwardly therefrom and an electrical prong (the second one 105) which extends outwardly therefrom; and a plug receptacle portion (50) disposed within the generator (400), said plug receptacle portion defining a recess for receiving said plug portion therein, said

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plug receptacle portion including a corresponding plurality of pin receptacles for receiving said pins from said plug portion and said plug receptacle also including a prong receptacle for receiving said prong, said prong receptacle including a smart connection which is backward compatible.

With regard to claim 2, Brassel et al disclose that the plug portion includes a plug housing having a power pin (107) extending therefrom.

With regard to claim 3, Brassel et al disclose that the power pin is positioned closer to a first side edge of the plug housing than a second side edge thereof, wherein the second side edge is opposite the first side edge thereof.

With regard to claims 4-6, Brassel et al disclose that the plug portion further includes a first (107) and a second (1070) position pin extending from the plug housing.

The connector system according to claim 2, further comprising a prong extending from the plug housing and substantially in the same direction as the power pin.

With regard to claims 27, 28, 29, 33, as they can be understood due to the 112 problem, Brassel et al disclose all of the limitations as applied to claims 1,2,7 above.,

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brassel et al.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to position the prong between the power pin and the first position pin, since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70.

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Claims 10-23, 30-32, 34-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brassel et al in view of Spink, Jr.

Spink et al (US 6,746,284 disclose that the prong (Fig. 5) includes a plurality of electrical contacts (22). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the prong with a plurality of electrical contacts as taught by Spink et al , to provide a variety of a desirable information and prevent cross-talking.

With regard to claim 11, Brassel et al or Spink et al disclose that the prong has a first geometry and said receptacle has a second geometry which is matingly compatible with said first geometry of said prong.

With regard to claims 12, 17, 18, Brassel et al - Spink et al disclose (Spink et al) that the prong (205) has a profile shape similar to a L-shaped cross-sectional profile and a rectilinear-shaped profile.

Applicants have presented no argument which convinces that the particular configuration of the prong is significant or is anything more than one of numerous configurations a person of ordinary skill in the art would find obvious for purpose preventing upside-down mating . In re Dailey, 149 USPQ 47 (CCPA 1976).

With regard to claim 13, Brassel et al - Spink et al disclose (Brassel et al) that the plug receptacle portion includes a housing operatively retained in the electrosurgical generator and defining a recess for receipt of the plug portion therein.

With regard to claim 14, Brassel et al - Spink et al disclose (Spink et al) that the plug receptacle portion includes a prong receptacle (302) formed therein, the prong receptacle being shaped and dimensioned to receive the prong therein.

With regard to claims 15, 16, Brassel et al - Spink et al disclose (Brassel et al) that the plug receptacle portion includes a plurality of apertures formed therein and contact terminals for receiving the power pin and the position pins therein.

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With regard to claim 19, Brassel et al - Spink et al disclose (Spink et al) that the plug receptacle portion includes at least one contact pin (32) extending therethrough.

With regard to claim 20, Brassel et al - Spink et al disclose (Spink et al) that the contact pins are positioned to contact a respective one of the electrical contacts (22) of the prong.

With regard to claims 21, 22, the geometrical limitations are not patentably significant since they relate to the size of the article under consideration which is not ordinarily a matter of invention. In re Yount, 36 C.C.P.A. (Patents) 775, 171 F.2d 317, 80 USPQ 141.

With regard to claim 23, Brassel et al - Spink et al disclose (Spink et al, Fig. 2) that a tactile feedback mechanism (305, 209) for providing positive feedback (a sound) to the user that the plug portion has been properly inserted into the plug receptacle portion .

With regard to claims 30-32, 34, 36-39 as they can be understood due to the 112 problem, Brassel et al when modified by Spink, Jr disclose all of the limitations as applied to respective claims 27, 12,14,23,25,21,22,17, 18 above.

Claims 25, 26, 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brassel et al in view of Reddersen et al or Lee et al

Reddersen et al (US 5,563,402) or Lee et al (US D505,390) disclose (1330 Redderson; Fig. 1 – Lee) symbology provided on a surface of the connector .

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Brassel et al with a label on the device's surface, as taught by Reddersen et al or Lee et al, to provide the operative information of the device

With regard to claim 35 as they can be understood due to the 112 problem, Brassel et al when modified by Reddersen et al or Lee et al disclose all of the limitations as applied to claims 25 above.

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***Allowable Subject Matter***

Claim 24 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 40 is allowed.

No prior art has been found to anticipate or render obvious the presently claimed subject matter.

Specifically, none of the prior art of record discloses the combination of the limitations presented including the specified features of the tactile feedback mechanism.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander D. Gilman whose telephone number is 571 272-2004. The examiner can normally be reached on Monday-Friday, 10:30 a.m. - 8:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula A. Bradley can be reached on 571 272-2800 ext. 33. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

\*\*\*

*Alex Gilman 01/13/06*

**ALEXANDER GILMAN  
PRIMARY EXAMINER**